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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/632,298	04/12/96	MOHSEN	A M-1007US

LM01/0622

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EXAMINER

JONES, H

ART UNIT PAPER NUMBER

2763

DATE MAILED: 06/22/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/632,298

Applicant(s)
Mohsen

Examiner
Hugh Jones

Group Art Unit
2763



☒ Responsive to communication(s) filed on Mar 5, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 20-28, 37-39, 42, 50-52, and 72-77 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20-28, 37-39, 42, 50-52, and 72-77 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 12

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2763

DETAILED ACTION

Terminal Disclaimer

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
4. Claims 20-28, 37-39, 42, 50-52 and 72-77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,377,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same scope of the invention.

Art Unit: 2763

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 20-28, 37-39, 42, 50-52 and 72-77 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by IBM Technical Disclosure (of record in application). See pp. 294-299 (especially figs. 6-7).

7. Claims 20-28, 37-39, 42, 50-52 and 72-77 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kung et al. (U. S. Patent 4,807,183; of record in application). See abstract; figs. 2-4; col. 1, line 25 to col. 2, line 32;

Response to Arguments

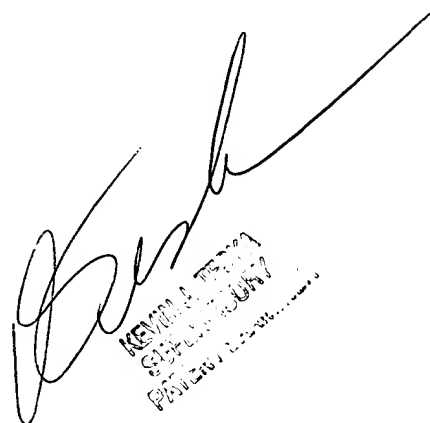
8. Applicant's arguments (3/5/99) with respect to claims 20-28, 37-39, 42, 50-52 and 72-77 have been considered but are moot in view of the new ground(s) of rejection.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Hugh Jones whose telephone number is (703) 305-0023.

Dr. Hugh Jones

June 20, 1999



A handwritten signature in black ink, appearing to read "Hugh Jones", is written over a rectangular stamp. The stamp contains the following text: "RECEIVED", "JUN 23 1999", "FEDERAL BUREAU OF INVESTIGATION", and "U.S. DEPARTMENT OF JUSTICE".